

04-25-01

A

04/23/01  
1052 U.S. PTO

jc872 U.S. PTO  
09/840722  
04/23/01

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Dkt. No.: UTSC:607USC1

Prior Application Examiner:  
SIU, S.

**BOX PATENT APPLICATION**  
Assistant Commissioner for Patents  
Washington, D.C. 20231

**Classification Designation:**  
435-006.000

**Prior Group Art Unit:** 1631

**CERTIFICATE OF EXPRESS MAILING**  
NUMBER: EL548523447US  
DATE OF DEPOSIT: April 23, 2001

**REQUEST FOR FILING CONTINUATION APPLICATION**  
**UNDER 37 C.F.R. § 1.53(b)**

This is a request for filing a continuation application under Rule 53(b) (37 C.F.R. § 1.53(b)) of co-pending prior application Serial No. 09/414,847 filed October 8, 1999, entitled "COMBINATORIAL OLIGONUCLEOTIDE PCR: A METHOD FOR RAPID, GLOBAL EXPRESSION ANALYSIS."

- ☒ 1. Enclosed is a copy of the prior application Serial No. 09/414,847 as originally filed, including specification, claims, drawings, and declaration. The undersigned hereby verifies that the attached papers are a true copy of the prior application as originally filed and identified above, that no amendments (if any) referred to in the declaration filed to complete the prior application introduced new matter therein, and further that this statement was made with the knowledge that willful

false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statement may jeopardize the validity of the application or any patent issuing thereon.

(a) ☒ The inventorship is the same as prior Application Serial No. 09/414,847.

(b) ☐ Deletion of inventor(s). Signed statement attached deleting inventor(s) named in the prior application, see 37 C.F.R. § 1.63(d)(2) and 1.33(b).

(c) ☐ Priority of foreign patent application number , filed in is claimed under 35 U.S.C. § 119(a)-(e). The certified copy:

☐ is enclosed.

☐ has been filed in the prior Application Serial No.

☒ 2. The Commissioner is requested to grant Applicants a filing date in accordance with Rule 1.53, and supply Applicants with a Notice of Missing Parts in due course, in accordance with the provisions of Rule 1.53(f).

☐ 3. Enclosed is a check in the amount of \$ to cover the filing fee as calculated below and the fee for any new claims added in the Preliminary Amendment referred to in Part No. 9 below.

CLAIMS AS FILED IN THE PRIOR APPLICATION  
LESS CLAIMS CANCELED BELOW

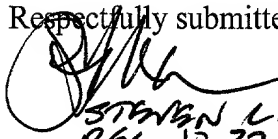
FOR	NUMBER FILED	NUMBER EXTRA	RATE	FEE
Basic Fee -----				\$355.00
Total Claims	84 - 20 =	64 X	\$9.00 =	\$576.00
Independent Claims	1 - 3 =	0 X	\$40.00 =	\$0.00
Multiple Dependent Claim(s) -----				\$-0-.00
<b>TOTAL FILING FEES:</b>				<b>\$931.00</b>

- ☒ 4. Applicant is entitled to Small Entity Status for this application.
- ☐ (a) A small entity statement is enclosed.
- ☒ (b) A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.
- ☐ (c) Small entity status is no longer claimed.
- ☒ 5. If the check is missing or insufficient, the Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 to 1.21 which may be required for any reason relating to this application, or credit any overpayment to Fulbright & Jaworski, L.L.P. Deposit Account No. 50-1212/10017175/01982.
- ☐ 6. Enclosed is a copy of the current Power of Attorney in the prior application.
- ☒ 7. Address all future communications to:
- David L. Parker  
FULBRIGHT & JAWORSKI, L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 474-5201
- ☒ 8. The prior application is presently assigned to Board of Regents, The University of Texas System.

- ☐ 9. Enclosed is a preliminary amendment. Any additional fees incurred by this amendment are included in the check at No. 3 above and said fee has been calculated after calculation of claims and after amendment of claims by the preliminary amendment.
- ☐ 10. Cancel in this application claims of the prior application before calculating the filing fee. (At least one original independent claim must be retained).
- ☒ 11. Amend the specification by inserting before the first line the sentence: --This is a continuation of co-pending application Serial No. 09/414,847 filed October 8, 1999 now issued as U.S. Patent No. 6,221,600--.
- ☒ 12. Enclosed are formal drawings.
- ☐ 13. An Information Disclosure Statement (IDS) is enclosed.
- ☐ (a) PTO-1449.
- ☐ (b) Copies of IDS citations.
- ☒ 14. Transfer the sequence information, including the computer readable form previously submitted in the parent application, Serial No. 09/414,847 filed October 8, 1999, for use in this application. **Under 37 C.F.R. § 1.821(e), Applicant states that the paper copy of the sequence listing in this application is identical to the computer readable copy in parent application Serial No. 09/414,847 filed October 8, 1999. Under 37 C.F.R. § 1.821(f), Applicants also state that the information recorded in computer readable form is identical to the written sequence listing.**
- ☒ 15. Other: Request for Transfer of Sequence Listing Under 37 CFR 1.821(e).

- ☒ 16. Return Receipt Postcard (should be specifically itemized).

Respectfully submitted,

  
STEVEN L. HIGHLANDER  
REG NO 37,642  
for David L. Parker  
Reg. No. 32,165  
Attorney for Applicants

FULBRIGHT & JAWORSKI, L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 474-5201

Date: April 23, 2001

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Michael C. MacLeod  
C. Marcelo Aldaz and  
Sara Gaddis

Serial No.: 09/414,847

Filed: October 8, 1999

For: COMBINATORIAL  
OLIGONUCLEOTIDE PCR: A METHOD  
FOR RAPID, GLOBAL EXPRESSION  
ANALYSIS

Group Art Unit: 1631

Examiner: Siu, S.

Atty. Dkt. No.: UTSC:607USC1

**CERTIFICATE OF EXPRESS MAILING**

NUMBER: EL548523447US

DATE OF DEPOSIT: April 23, 2001

**REQUEST FOR TRANSFER OF SEQUENCE LISTING UNDER 37 C.F.R. § 1.821(e)**

**BOX SEQUENCE**

Commissioner for Patents  
Washington, D.C. 20231

Commissioner:

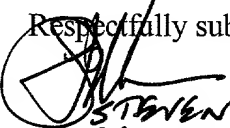
Pursuant to 37 C.F.R. § 1.821(e), Applicants respectfully request that the sequence information previously submitted in parent application ("parent application"), U.S. Serial No. 09/414,847 filed October 8, 1999, be transferred to and used in the above-referenced patent application ("instant application"). Only one computer readable sequence listing was submitted to the U.S. Patent and Trademark Office in the parent application. The sequence information in the instant application is identical to the sequence information contained in the previously-filed

computer readable sequence listing in the parent application. It is understood that the U.S. Patent and Trademark Office will make the necessary change in application number and filing date of the computer readable form that will be used for the instant application. A paper copy of the sequence listing is included in the originally-filed specification of the instant application.

Applicants request the transfer of the previously-filed computer readable sequence listing from the parent application to the instant application is in lieu of filing a duplicate computer readable sequence listing.

No fee is believed to be due in connection with the filing of this document; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be deemed necessary for any reason relating to this document, the Commissioner is hereby authorized to deduct said fee from Fulbright & Jaworski Account No.: 50-1212/1000171475/01982.

Respectfully submitted,

  
STEVEN L. HIGHLANDER  
Reg. No. 37,612  
for David L. Parker  
Reg. No. 32,165  
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 474-5201

Date: April 23, 2001